

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Chung-Wen Wang

Confirmation No. 2029

Serial No.: 10/747,726

Group Art Unit: 3623
Examiner: Anderson, Folashade

Filed: December 29, 2003

Docket No. 252011-1380
Top-Team Ref. 0503-9727US

For: Systems and Methods For Capacity Reservation

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop – Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant appeals the rejections set forth in the FINAL Office Action mailed in this application. Applicant submits that the FINAL Office Action mailed in this application embodies clear error. Therefore, Applicant is requesting a pre-appeal brief review of the rejections. These remarks are provided in support of that request.

Response to Rejections under 35 U.S.C. § 103

Claims 1, 6, 9, 11, and 14 are rejected under U.S.C. § 103(a) as allegedly being unpatentable over Singh et al. (US Patent. No. 7,080,026) in view of Kennedy (US Patent. No. 6,188,989) and Official Notice. Claims 5, 10 and 15 are rejected under U.S.C. 103(a) as being unpatentable over Singh in view of Kennedy, Official Notice, and in further view of Boarders et al (US Patent. No. 7,139,721).

Among these rejected claims, claims 1, 6, and 11 are independent. Claims 6 and 11 are rejected on the same basis as claim 1. Therefore, remarks are provided with respect to the patentability of independent claim 1, with the understanding that these comments are similarly relevant to the rejections of claims 6 and 11.

The Office Action (page 3) states that the recitation ‘capacity reservation based on historical customer delivery data’ has not been given patentable weight because the recitation occurs in the preamble. First, the MPEP makes clear that, in situations like this, the “capacity reservation based on historical customer delivery data” of the claims should, in fact, be treated as a positive claim limitation. In this regard, MPEP 2111.02 states:

MPEP § 2111.02 Effect of Preamble

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). See *id.* at 808-10, 62 USPQ2d at 1784-86 for a discussion of guideposts that have emerged from various decisions exploring the preamble's effect on claim scope, as well as a hypothetical example illustrating these principles.

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "**If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim.**" *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003)(In considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," **the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose.**). *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (**A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.**).

I. PREAMBLE STATEMENTS LIMITING STRUCTURE

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that

preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (*The claim at issue was directed to a driver for setting a joint of a threaded collar; however, the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver.* "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." Id. at 1073, 828 F.2d at 754.).

(*Emphasis added*). The portions of MPEP 2111.02, which have been emphasized above, make it clear that the "capacity reservation based on historical customer delivery data" of the present claims cannot be properly ignored, as has been done by the FINAL Office Action.

Further, Applicant notes that the feature is not only described in the preamble, but is also implied in the claim body. Accordingly, the feature of: 'capacity reservation based on historical customer delivery data' is the consequential outcome of claim 1. According to claim 1, customers are classified into a plurality of different categories according to the historical customer delivery data, and production capacity is reserved for the customers in accordance with the different categories. Since the production capacity is reserved according to the different categories and these categories are generated according to the historical customer delivery data, the feature of 'capacity reservation based on historical customer delivery data' cannot be properly ignored, and therefore has consequential outcome in the claimed method.

For at least this reason, the rejection of claim 1 should be overturned. Should the Examiner disagree and maintain that preamble features are to be ignored, Applicant respectfully requests that the Examiner provide a more detailed explanation of the position, particularly in view of the MPEP provisions set forth above.

The Office Action (page 4) states that because Singh teaches 'letting users create forecast from shipments data' and Kennedy teaches 'promises made to those requests become allocated to that sales entity.' The Office Action, therefore, concluded

that the combination teaches ‘capacity reservation based on historical customer delivery data’.

In addition, the Office Action (pages 7-8) states that Singh teaches using shipments data for capacity reservation; Kennedy teaches reserving production capacity for the customers in accordance with the different categories; and fixed, floating, and distributed delivery time requirement types are well known. The Office Action further states that the claimed invention can be obtained from combination of the cited features.

Applicant respectfully disagrees.

According to Singh (abstract), a customer uses shipment data to determine forecasts. Consequently, the shipment data serves as a basis for forecast determination. In addition, the forecast determination taught by Singh is executed by a customer, rather than by a supplier. According to Kennedy (see col. 3, second paragraph), promises made to those requests become allocated to that sales entity to meet the forecast created by the sales entity.

Based on the cited sections of Singh and Kennedy, the combination of the cited references is as follows: on the customer side, the customer uses shipment data for demand forecasting; and in a supplier side, promises to the customer-determined forecasts are made in accordance with a hierarchy of customers (seller entities).

To one of ordinary skill in the art, the method for capacity reservation of claim 1 cannot be obtained from the combination of Singh, Kennedy, and the Official notice for at least the following reasons:

First, the express claim language (and common sense), it should be understood that the claimed method is executed by a supplier side for reserving production capacity for a plurality of customers. Accordingly, all the steps of acquiring, classifying, and reserving are performed by a supplier.

On the contrary, the combination of cited art teaches that on the customer side, the customer uses shipment data for demand forecasting; and in a supplier side, promises to the customer-determined forecasts are made in accordance with a hierarchy of customers (seller entities). In the combination, the supplier does not utilize the shipments data of a particular customer for production reservation.

From the description of claim 1, historical customer delivery data is utilized as a basis for classifying customers, and the classification result is utilized as a basis for production capacity reservation. In other words, historical customer delivery data serves as a determinant in production capacity reservation for customer-determined demand requests.

Singh simply teaches using shipments data as a determinant in forecast determination. Neither Singh nor Kennedy teaches using historical customer delivery data serves as a determinant in production capacity reservation for customer-determined demand requests.

For at least the foregoing reasons, teachings of Singh, Kennedy and the so-called ‘old and well known art’ do not suggest all features of the claim 1 to one of ordinary skill in the art. The proposed modification of the applied references CANNOT properly achieve the claimed subject matter. Accordingly, the rejection of claim 1 should be withdrawn.

On the same basis as claim 1, rejections of claims 6 and 11 should also be withdrawn. Insofar as all remaining claims depend from claims 1, 6, or 11, the rejections of all remaining claims should be withdrawn for the same reasons. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

A credit card authorization is provided herewith to cover the fee associated with the accompanying Notice of Appeal. No additional fee is believed to be due in connection with this submission. If, however, any additional fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

/Daniel R. McClure/

Daniel R. McClure, Reg. No. 38,962

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1500
600 Galleria Parkway S.E.
Atlanta, Georgia 30339
(770) 933-9500